

**REMARKS****I. Support for Amendments to Claims**

Initially, the Applicant refers to the preliminary amendment to the claims, filed with the application on April 28, 1999. These amendments removed many of the improper multiple dependent claims, and are considered as having been entered in the presentation of claims above (that is, they appear as non-amended text).

Claim 39 is canceled without prejudice to filing in future continuing or divisional applications.

Claims 14-26 are withdrawn claims and canceled as drawn to non-elected subject matter. Applicants note the finality of the restriction, maintain the traverse argument of record, and cancel claims merely in order to further prosecution of the application.

Claim 1 is amended in order to help clarify the subject matter of the invention and the claim language.

Claim 2 is amended to correct its dependency, and to clarify its language.

Claim 3 is amended to clarify its language and provide proper antecedent basis.

Claims 4 and 5 are not currently amended.

Claim 6 is amended to clarify its language.

Claim 7 is not currently amended.

Claim 8 is amended to clarify its language and provide proper antecedent basis.

Claim 9 is amended to correct a typographical error.

Claim 10 is amended to provide proper language for a multiply dependent claim.

Claim 11 is amended to provide proper antecedent basis.

Claim 12 is amended to clarify its language.

Claim 13 is amended to clarify its language.

Claim 27 is amended to provide proper antecedent basis, and to remove improper multiple dependency language.

Claim 28 is amended to clarify its language.

Claims 29 and 30 are amended to provide proper antecedent basis.

Claim 31 is amended to clarify its language and provide proper antecedent basis.

Claim 32 and 33 are amended to provide proper antecedent basis, and to clarify the

language.

Claim 34 is amended to clarify its language and provide proper antecedent basis.

Claim 35 is amended to provide proper antecedent basis.

Claim 36 is not currently amended.

Claim 37 is amended to clarify its language and to provide proper antecedent basis.

Claim 38 is amended to provide proper antecedent basis.

Claim 40 is amended to clarify its language.

These amendments address the linguistic form of the claims. All of the above amendments are fully supported in the application as filed, and do not constitute new matter.

### **THE OFFICE ACTION**

#### **I. Various formal Objections**

##### **A. Objection to the Drawings**

Figures 2 and 4A are objected to because of alleged improper reference numerals, particularly numeral "102" (Fig. 2), and no arrow extending from "65" (Fig. 4A). Applicant submits replacement drawing sheets containing amended Figure 2 and Figure 4A.

Specifically, Figure 2 is amended to replace the numeral 102, locating the position of "rotatable disc", with numeral 104. This amendment is supported in application, for example, the original drawing (see the expanded view) and well as page 19, lines 8-19.

Figure 4A is amended by deletion of reference numeral 65, as it indicates the presence of a mandrel, as described on page 22, lines 21-28, and Figs. 4B and 4D, which is not present in the embodiment depicted in Fig. 4A.

None of the amendments to the drawings constitute new matter, and are fully supported by the specification. The Applicants believe that these amendments to the Figures remove the pending objections to the drawings.

##### **B. Objection to the Disclosure**

The disclosure is objected to for alleged improper recitation of reference numerals, specifically numeral 70, to describe multiple elements of the invention. The specification is

Approved  
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Correction  
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amended as noted above. The amendments are fully supported by the original disclosure, including the Figures, and do not constitute new matter. Accordingly, the Applicants believe that the amendments to the specification remove the pending objections to the disclosure.

C. Objection to Claims

Claims 28 and 30-39 stand objected under 37 C.F.R. § 1.75(c), alleged to be in an improper multiple dependent form. The claims are amended as noted above, rendering this objection moot.

II. **Rejections under 35 U.S.C. § 112, second paragraph**

Claims 12 and 27-34 stand rejected under 35 U.S.C. § 112, 2<sup>nd</sup> ¶, alleged to be indefinite due to lack of proper antecedent basis.

As noted above, the claims are amended in many instances to provide correct antecedent basis. Thus, the Applicants believe this rejection is now moot.

III. **Rejections under 35 U.S.C. § 102(b)**

Claims 1-4, 8, 10-13, 27, 30/27, and 40 stand rejected under 35 U.S.C. § 102(b), alleged to be anticipated by the disclosure of Holguin (WO 97/39687). Specifically, Holguin is alleged to disclose a suturing means for connecting a tubular vascular prosthesis to a blood vessel in the body comprising an internal annular member, intended to be applied around the blood vessel essentially at the location of the internal annular member in order to receive the vessel wall between both annular members, in which at least one of the two annular members is provided with suturing members which, at least in a connected state, grip in the vessel wall, fixating at least the internal annular member, characterized in that the internal annular member comprises a ring-like element intended to be firmly connected to an outer end of the vascular prosthesis that the external annular member and the ring-like element are capable of mutual cooperation so as to clamp the vessel wall there between. The Applicants respectfully traverse the rejection.

According to the MPEP, “(a) claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference” (citing *Verdegaal Bros v. Union Oil Co. of California*, 814 F.2d 628, 631). MPEP §

2131.

Holguin neither teaches nor suggests the claimed invention. Rather, Holguin merely discloses a conventional intra-vascular method of treating a patient. It teaches an intra-luminal prosthesis that is advanced intravascularly to the injured vessel, together with a graft retention system (pg. 3, line 17). Holguin does not teach or suggest, for example, suturing members that fix the internal annular member that is firmly connected to the prosthesis, or a continuous support surface along its circumference for receiving the vessel wall. Therefore, Holguin does not anticipate the invention as claimed.

In light of the above argument, the Applicants respectfully request reconsideration and withdrawal of the rejection of claims under 35 U.S.C. § 102(b).

#### **IV. Rejections under 35 U.S.C. § 103(a)**

Claims 5, 29, and 30/29 stand rejected under 35 U.S.C. § 103(a), alleged to be obvious and unpatentable in light of Holguin (WO 97/39687). Specifically, it is alleged that it would have been obvious to form external annular members from plastic since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice, citing to *In re Leshin*, 125 USPQ 416. The Applicants respectfully traverse this rejection.

According to the Federal Circuit, “The PTO bears the burden of establishing a case of *prima facie* obviousness. A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.” *In re Bell*, 991 F.2d 781 (Fed. Cir. 1993). In addition, the Federal Circuit has stated that a determination of obviousness requires that the prior art suggests both (1) that the claimed invention should be made and (2) that one skilled in the art would have a reasonable expectation of success. *In re Dow Chemical Co.*, 837 F.2d 469 (Fed. Cir. 1988). Further, the alleged art references must teach or suggest each element of the claimed invention.

As argued above, Holguin fails to teach or suggest each element of the invention as claimed, for example, suturing members that fix the internal annular member that is firmly connected to the prosthesis, or a continuous support surface along its circumference for receiving the vessel wall. As further evidence of the non-obviousness of the claimed invention, Holguin

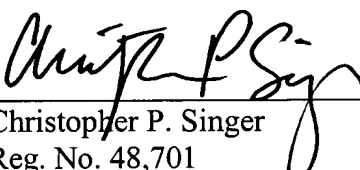
does not teach or suggest that its prosthesis prevents, or substantially prevents, endo-leaks because the retention system does not provide a continuous and firm junction support for the vessel wall. Thus, the instant invention provides more benefits than taught or suggested by Holguin. Further, claims 5, 29, and 30 are dependent on the patentable suturing means of claim 1. Accordingly, the Applicants respectfully request reconsideration and withdrawal of the rejection of claims under 35 U.S.C. § 103(a).

#### **V. Conclusion**

In light of the above response and amendment, the Applicants believe that the claims are now in condition for allowance. Should the Examiner have any questions regarding this response, or believe that a telephonic interview would help to expedite prosecution of this application, he is invited to contact the undersigned at (312) 913-0001.

Respectfully submitted,  
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